

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ARTHUR P. FRAAS,
RICHARD L. FURGERSON,
and
HAROLD L. FALKENBERRY

Appeal No. 1999-2120
Application No. 08/835,419

ON BRIEF

Before GARRIS, WARREN, and TIMM, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to a request, filed February 25, 2002, for rehearing of our decision, mailed January 24, 2002, wherein we sustained the examiner's Section 102 and Section 103 rejections of claims 1-4, 6, 9, 11-14, 16, 19, 22 and 23 based on the Selepe reference of record.

On pages 3-5 of our decision, we explained that the injection of steam or clean product gas in Selepe's apparatus and

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process would necessarily perform the coal preheating and oxygen removing functions recited in the appellants' independent apparatus and process claims. In the subject request, the appellants argue that the steam used in Selep's apparatus and process would not perform these functions.¹ According to the appellants, "it is impossible for Selep's use of steam to even heat the coal particles" because "Selep's steam is merely used to clean the blades of clinged coal [and] [t]he coal particles are already gone at the time the steam is used to clean the blades of any clinged coal particles" (request, page 2).

This argument is unpersuasive for a number of reasons. First, not all of the claims under consideration require the coal to be preheated (e.g., see independent claim 23). Second, even if the coal preheating (and oxygen removing) functions are not actually performed by Selep, the Section 102 and Section 103 rejections of the appealed apparatus claims nevertheless would be proper as long as patentee's apparatus is capable of performing such functions. In re Yanush, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973); In re Glass, 474 F.2d 1015, 1019, 176 USPQ 529,

¹We here emphasize that the appellants' argument is limited to our position concerning the use of steam by Selep and does not address our corresponding position concerning the use of clean product gas by Selep.

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532 (CCPA 1973). Third, as implicitly acknowledged by the appellants in their above-quoted argument, Selep's steam would contact coal particles clinging to the blades of patentee's apparatus as well as the surrounding apparatus structure. This steam of necessity would heat at least to some extent these coal particles and the surrounding structure. In our view, it is reasonable to consider the preheating of these particles and the surrounding structure as satisfying the coal preheating and/or the oxygen removing functions recited in the appealed independent claims. That is, coal particles would be preheated (and thus deoxygenated) either by contact with the steam directly or by contact with the surrounding structure which had been previously heated via the aforementioned steam.²

Though not expressly argued, it is implied in the subject request that our decision sustaining the examiner's Section 103 rejection of the previously-noted claims involved the use of a new reference, namely, Hawley's Condensed Chemical Dictionary and correspondingly that our decision therefore involved a new ground of rejection. It is true that we consulted this

²We again emphasize that these arguments concern only the steam and not the clean product gas of Selep with respect to the inherent practice of coal preheating and oxygen removing functions.

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dictionary for a definition of the term "gasification" (see the paragraph bridging pages 5 and 6 of our decision). As a matter of clarification, however, it is clear that such consultation does not constitute the application of a new reference or the creation of a new ground of rejection. See In re Boon, 439 F.2d 724, 727-28, 169 USPQ 231, 234 (CCPA 1971).

Finally, we note that pages 3 and 4 of the appellants' request present as "argument" the mere reiteration of claim limitations. As explained in footnote 1 on page 3 of our decision, the mere reiteration of claim limitations cannot be regarded as an argument within the meaning of 37 CFR § 1.192(c)(7)(8)(1998). The propriety of our position on this matter is well exemplified by the appellants' comments on page 11 of the brief which present the features recited in these claims without even characterizing these features as novel much less nonobvious over the applied prior art.


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For the above-stated reasons, we deny the appellants' request with respect to making any changes in our January 24, 2002 decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

BRADLEY R. GARRIS
Administrative Patent Judge


CHARLES F. WARREN
Administrative Patent Judge


CATHERINE TIMM
Administrative Patent Judge

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